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| 22511 7590 11/25/2003 | | | | |
| ROSENTHAL & OSHA L.L.P. 1221 MCKINNEY AVENUE SUITE 2800 HOUSTON, TX 77010 | | | | |
| EXAMINER KIM, AHSHIK | | | | |
| ART UNIT 2876 | | PAPER NUMBER | | |

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,681

Applicant(s)

LEYDIER, ROBERT

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/01/02 (Preliminary Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers
5 have been placed of record in the file (paper #2).

Preliminary Amendment

2. Receipt is acknowledged of the preliminary amendment filed on July 1, 2002. In the amendment claims 1-7 were amended. Currently claims 1-7 remains for examination.
- 10 Examiner also notes that in the enclosed specification of the application (in page 18-19) claims 1-12 were listed. Examiner respectfully requests the Applicant, in responding to this Office Action, to delete 18-19 of the specification to avoid confusion with respect to outstanding claims in the examination.

Claim Objections

- 15 3. Claims 1, 2, 3, and 7 are objected to because of the following informalities:
- Re claim 1, line 3: substitute "the said microcontroller" with --said microcontroller--.
- Re claim 1, line 8, substitute "the said interface" with --said interface--.
- Re claim 1, line 9: substitute "said confidential data" with --said confidential
20 information--.
- Re claim 2, line 3: substitute "the said contact" with --said contact--.
- Re claim 2, line 5: substitute "the said supply" with --said supply--.

Re claim 3, line 3: substitute "the said data" with --said data--.

Re claim 7, line 1: delete "intended to be".

Appropriate correction is required.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Odinak (US 6,419,159).

Re claims 1 and 7, Odinak teaches a smart card 30 (col. 2, line 38 – col. 3, line 22) comprising an integrated circuit 10 further comprising a micro controller 12, a plurality of contacts (col. 2, lines 65+) to receive power and data from external sources, wherein the card carries sensitive/confidential information (col. 1, lines 15+), and the power protection circuitry 40 performs power fluctuations during the operation so that important data may not be compromised to unauthorized individual(s) (col. 3, lines 23-40).

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Re claims 5, 6, the card is created according to the ISO-7816 standard (col. 3, lines 15+) or utilizing the medium such as plastic, which provides necessary protection and rigidity for the card. Although not explicitly mentioned, the contacts need to be arranged so that they would interface with external devices.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 7. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odinak (US 6,419,159) in view of Basentsch (US 6,264,108). The teachings of Odinak have been discussed above.

Re claims 2 and 3, Odinak additionally discloses that a multiple number of current sinks
15 42(1) to 42(N) (see figure 1) connected between the power source Vcc and ground contacts are used in creating unpredictable power consumption levels (col. 3, lines 41+; col. 4, lines 19+).

However, Odinak fails to specifically teach or fairly suggest that a capacitor is connected between the supply terminal and another supply terminal.

Basentsch teaches an IC card comprising a shield for detecting an intrusion and a
20 protection unit for controlling sensitive information (see abstract). The card further uses a capacitor 15 to maintain a certain voltage for a short period of time (col. 4, lines 38+).

In view of Basentsch's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known capacitor to the teachings of Odinak in order to provide flexibility in controlling the voltage level. It is well known that capacitors are
25 used in IC chip embodiment to temporarily hold or adjust the voltage. In fact, source-to-drain 46 in each current sinks 42 (1),, 42 (N) can very well be a capacitor. Accordingly, utilizing

capacitors in IC chip to adjust voltage as shown by Basentsch would have been an obvious expedient, well within the ordinary skill in the art.

Re claims 4, farad is a unit of capacitance for capacitors. Accordingly, one would choose a capacitor of a particular capacity, which suit his/her system. For example, signal to noise ratio is relatively large, capacitors for large voltage may be selected. In opposite cases, small capacitors may be required. Since capacitors are already disclosed in IC chip, unit of capacitors alone would not be a patentable subject matter unless Applicant clearly shows why claimed capacitors are patentable over other capacitors.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Pitsch (US 6,164,550); Lafon et al. (US 5,889,272); Yamaguchi (US 5,432,328); Kushima (US 4,785,166) disclose smart cards obscuring voltage use for protection.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim
Patent Examiner
Art Unit 2876
November 14, 2003

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MICHAEL G. LEE
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